

REMARKS

Claims 1 through 34 are pending in this application. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 1 through 20. Applicants also acknowledge, with appreciation, the Examiner's indication that claims 29 and 30 would be allowed if presented in independent form. Accordingly, the only remaining issue pivots about the patentability of claims 21 through 28 and 31 through 34.

Claims 1, 3, 5, 7, 9 through 17, and 21 through 34 have been amended. Care has been exercised to avoid the introduction of new matter. The present claim amendments have been implemented for clarification and find adequate descriptive support throughout the originally filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 21 through 26 were rejected under the second paragraph of 35 U.S.C. §112.

In the statement of the rejection, the Examiner asserted that the recitations "means for" or "step for" modified by structure, material, or acts render the claimed invention indefinite.

This rejection is traversed. Specifically, claims 21 through 26 have been clarified by deleting the "means for" language, thereby overcoming the stated basis for the rejection. Applicants, therefore, submit that imposed rejection of claims 21 through 26 under the second paragraph of 35 U.S.C. §112 is not legally viable and, hence, solicit withdrawal thereof.

Claims 27, 28, 33, and 34 were rejected under 35 U.S.C. §102(e) for lack of novelty as evidenced by Linden et al. ("Linden").

In the statement of the rejection, the Examiner asserted that Linden discloses apparatus identically corresponding to that claimed, referring to Fig. 1 and asserting that client 1 is a packet data device which is an integral part of a mobile station or is attachable to a mobile station. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102(e) requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Further, as a matter of procedural due process of law, the Examiner is required to specifically identify where in an applied reference is alleged to disclose each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). That initial burden has not been discharged. Moreover, there are fundamental differences between the claimed apparatus and the apparatus disclosed by Linden that scotches the factual determination that Linden discloses, or even remotely suggests, an apparatus identically corresponding to that claimed.

Specifically, the claimed invention involves processing location information relating to a packet data device, which is connected to a packet data network via an access network capable of determining location, and for providing location information to a network element, which is connected to the packet data network, after authenticating the network element requesting the

location information. See for example paragraph [0012]. Furthermore, a cellular network, such as GRPS and GSM, can be used as access network to packet data networks. A packet data device can be connected to a mobile station, and via the mobile station and a cellular network, the packet data device can communicate with a packet data network. See for example paragraph [0004].

Based upon the foregoing, one having ordinary skill in the art would have understood that in accordance with the claimed invention, a data packet device communicates with a packet data network via a mobile station and a cellular network. No such communication is disclosed, suggested, or possible in Linden's system. This is because, as a factual matter, client 1 in Fig. 1 of Linden is **not a separate entity**. Instead, as one having ordinary skill in the art would have understood, client 1 in Fig. 1 is merely **symbolic** of one of the mobile stations (MS). This is clear from Linden's disclosure as, for example, column 6, lines 1 through 5 and column 8, lines 61 through 64. Therefore, as a factual matter, Linden fails to disclose a packet data device being an integral part of a mobile station or being attached to a mobile station, as in the claimed invention.

The above argued functionally significant structural difference between the claimed apparatus and the apparatus disclosed by Linden undermines the factual determination that Linden discloses an apparatus identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 27, 28, 33, and 34 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Linden is not factually viable and, hence, solicit withdrawal thereof.

Claims 31 and 32 were rejected under 35 U.S.C. §103(a) for obviousness predicated upon Linden in view of Wang et al. (“Wang”).

This rejection is traversed. Specifically, each of the rejected claims depends directly or indirectly from independent claim 27. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 27 under 35 U.S.C. §102(e) for lack of novelty as evidenced by Linden. The secondary reference to Wang does not cure the previously argued deficiency of Linden. Indeed, Wang discloses communicating auxiliary information between cellular telephone network and a Global Positioning System. See, for example, column 2, lines 27 through 30. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants certainly do not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claims 31 and 32 under 35 U.S.C. §103(a) for obviousness predicated upon Linden in view of Wang is not factually or legally viable and, hence, solicit withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed rejections have been overcome, and that all pending claims are in condition for immediate allowance. Favorable consideration therefore is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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February 2, 2010
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